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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,511	04/26/2001	Richard Llewellyn Powell	INE 005 CIP	7335

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EXAMINER

COE, SUSAN D

ART UNIT	PAPER NUMBER
1654	

DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/842,511	POWELL ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Susan Coe	1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 May 2003.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 38-63 is/are pending in the application.
- 4a) Of the above claim(s) 41-50 and 58-63 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 38-40 and 51-57 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. 08/716,269.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1,6,7&amp;8</u> .	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

1. Claims 38-63 are currently pending.

***Election/Restrictions***

2. Applicant's election with traverse of Group I, claims 38-45 and 51-58, a flavored composition for species A, 1,1,2,3,3,3-heptafluoropropane for species B, and a C<sub>2-4</sub> alkane for species C in Paper No. 13, dated May 5, 2003 is acknowledged. The traversal is on the ground(s) that Groups I and II should not be restricted from each other because a search of Group I would overlap with a search of Group II. This is not found persuasive because while a search of both groups would overlap to some extent, they would not necessarily be coextensive because Group II contains limitations that are not part of Group I.

In addition, applicant argues that aromatic composition and flavored composition should not be restricted from each other because flavors and aromas are related to each other. While this might be true, the "aromatic" limitation also reads on aromatic chemical compositions which are not related to flavor. Thus, due to the dual means of "aromatic" these two compounds are considered properly restrictable. In addition, applicant argues that "oils" and "compositions" should not be restricted; however, these two terms do not overlap in every instance. Therefore, a different search is required. Thus, they are properly restricted.

The requirement is still deemed proper and is therefore made FINAL.

3. In regards to the examination of the elected species, the use of the elected species, a C<sub>2-4</sub> alkane, as the cosolvent in combination with 1,1,2,3,3,3-heptafluoropropane is considered allowable. Additionally examined species for C, a C<sub>2-6</sub> hydrocarbon, a dialky ether, dimethyl

ether, and butane are all considered to be allowable in combination with 1,1,2,3,3,3-heptafluoropropane. The use of 1,1,2,3,3,3-heptafluoropropane with any cosolvent (as claimed in claim 40) is not considered allowable for the reasons stated in paragraph 8. Additional species are selected for examination. Examination was conducted with a flavored composition for species A, hydrofluoropropanes for species B and C<sub>2-4</sub> alkanes for species C.

4. Claims 41-50 and 58-63 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 13.
5. Claims 38-40 and 51-57 are examined on the merits.

#### ***Claim Objections***

6. Claim 56 is objected to as being dependent on a non-elected claim.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

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do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 38-40, 51, 56 rejected under 35 U.S.C. 102(e) as being anticipated by US Pat. No. 5,512,285 (filing date February 17, 1994).

Applicant's claims are drawn to extracting a flavored composition from a raw material using 1,1,1,2,3,3,3-heptafluoropropane and a cosolvent.

US '285 teaches extracting flavored compositions from raw materials using 1,1,1,2,3,3,3,-heptafluoropropane and a cosolvent (see abstract and column 5, lines 8-25).

9. Claims 38, 39, 51-56 and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 2 225 205 A.

Applicant's claims are directed towards extracting a flavored composition from a raw material using a hydrofluoropropane and a C<sub>2-4</sub> alkane. These are the species examined. The reference has additional species in the disclosure; therefore, these species are included in the rejection.

US '205 teaches using liquefied gases to extract oils from potatoes. Oils would be flavored. The solvents used are difluoromethane, hydrofluoropropanes, butane, and dimethyl ether (see page 5).

10. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (703) 306-5823. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (703) 306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Susan Coe, Examiner  
May 21, 2003



FRANCISCO PRATS  
PRIMARY EXAMINER